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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/046,287 | 01/16/2002 | Tetsuya Hashimoto | 217053US-2CONT | 5872 |

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| EXAMINER |
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HO, TUAN V

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| ART UNIT | PAPER NUMBER |
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2615

DATE MAILED: 07/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 10/046,287 | Applicant(s) HASHIMOTO ET AL. | |
| | Examiner Tuan V. Ho | Art Unit 2615 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-34 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 34 is/are allowed.
- 6) ☒ Claim(s) 16 and 19-31 is/are rejected.
- 7) ☒ Claim(s) 17,18,32 and 33 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 08/606,196.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

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1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 16 and 19-31 are rejected under the judicially created doctrine of double patenting over claims 5-8 of U. S. Patent No. 6,111,604 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

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With regard to claim 16, claims 5-8 of the Patent'604 discloses the digital camera (electronic camera is connected to an external device), camera body (lens and light sensor are arranged in a camera housing so as to perform camera functions), central processing unit (a switch determines whether the camera is to record or play or transmit or receive images in claim 6, wherein the switch inherently includes a control unit that can be used to perform the functions), a mode selector including at least one selector on the body for selecting an operating mode (the switch can perform mode selections); a connector for providing a connection (means for detecting), wherein the central processing unit is programmed to detect a signal from a computer upon connection of the camera to the computer and in response to the connecting operation automatically switch the operating mode of the digital camera out of a current operating mode selected by the mode selector and into the communication mode (the control unit controls the means for detecting so as to detect a signal from external device and automatically switch camera modes in claim 8), except for the digital camera for use with a computer and central processing unit.

Official Notice is taken for a digital camera connected to a computer and the camera control unit is a CPU.

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Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the claimed electronic camera so as to obtain a digital camera for use with a computer and a CPU since the digital camera using a CPU speedily processes digital images and easily to transmit to a computer for displaying on a monitor or transmit to a computer network.

With regard to claim 19, the Patent'604 discloses the picture memory (memory connected to the light sensor).

With regard to claim 20, the Patent'604 discloses the removable memory (Official Notice is taken for a removable memory; therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the memory of claim 5 so as to obtain a removable memory and thereby to easily replace the memory when it is full and thereby to improve the efficiency of the camera operations).

With regard to claim 21, the Patent'604 discloses the central processing unit includes a single chip (the CPU is inherently a single chip).

With regard to claim 22, the Patent'604 discloses the central processing unit includes plural components (the CPU is inherently included a plurality component in order to move and process data signals).

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With regard to claim 23, the Patent'604 discloses the central processing unit sets up appropriate communications algorithms so that the camera is prepared to communicate with the computer (the CPU controls the means for communicating where communicating sets up a program in order to communicate with the computer).

With regard to claim 24, the Patent'604 discloses the standard communication protocol (the CPU inherently communicates with the computer through a standard communication protocol).

With regard to claim 26, the Patent'604 discloses the lens which is carried within the body (Official Notice is taken for a lens arranged in a camera body; therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the lens in order to be in the camera body because the arrangement would make a compact design for the camera due to no camera protruding from the camera body).

With regard to claim 27, the Patent'604 discloses the light sensor is a CCD sensor (Official Notice is taken for a CCD image sensor; therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the light sensor so as to obtain a CCD light sensor because A CCD light sensor is easily and less expensive to fabricate).

Claims 28, 29 and 31 recites what was discussed with respect to claims 16, 20 and 24.

With regard to claim 30, the Patent'604 discloses the control means includes a central processing unit and further includes signal processing means for processing data from the CCD sensor and image data compression means for compressing data from the signal processing means prior to recording in the picture memory (Official Notice is taken for a compression circuit that is used to compress image data; therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the compression circuit into the camera circuit of claims 16 so as to compress image data and thereby to provide more storage capacity for the memory).

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

3. Claims 17, 18, 32 and 33 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten

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in independent form including all of the limitations of the base claim and any intervening claims.

4. Claim 34 is allowed.

The prior art of record fails to suggest or disclose
A method for controlling a digital camera having a connector for connection to a computer, comprising the steps Of detecting by the camera the operation of connection to a computer by monitoring a pin of a connector of the camera and detecting the presence of a signal from the computer on the pin; switching the operating made of the camera, in response to the detection of the presence of the signal, out of the mode selected by the mode selector so as to prevent recording from the image sensor or playback to a display and into a communications mode in which the camera communicates with the computer; and
Communicating Picture information from the camera to the computer while in the communication mode.

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Aizawa et al cited by Applicants (5,539,535) discloses aan electronic camera that includes a state detection circuit where the circuit detects a state of external data access being in a

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ready state and inhibition circuit to inhibit a changeover to internal access.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to TUAN HO whose telephone number is (571) 272-7365. The examiner can normally be reached on Mon-Fri from 7AM to 4PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, David Ometz can be reached on (571) 272-7593. The fax phone number for the organization where this application or proceeding is assigned is (572) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Customer Service whose telephone number is (571) 272-2600.



TUAN HO,

Primary Examiner

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